



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,804	02/09/2001	David L. Goodale	2048-039	8653
22471	7590	12/14/2004	EXAMINER	
PATENT LEGAL DEPARTMENT/A-42-C BECKMAN COULTER, INC. 4300 N. HARBOR BOULEVARD BOX 3100 FULLERTON, CA 92834-3100			HANDY, DWAYNE K	
			ART UNIT	PAPER NUMBER
			1743	
DATE MAILED: 12/14/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

VW

Office Action Summary	Application No.	Applicant(s)
	09/780,804	GOODALE ET AL.
	Examiner Dwayne K Handy	Art Unit 1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 September 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,4-30 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,4-10 and 21-30 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 2, 4-10 and 21-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended claims 1 and 21 to include the limitation of an alignment arm that limits movement of the blade to the longitudinal axis. This is a negative limitation that appears to be unsupported by the specification. Applicant has not provided any support for such a limitation and the Examiner has failed to find any support in the specification for movement of the blade to be limited in such a manner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1743

4. Claims 1, 2, 4-7 and 21-27 were previously rejected under 35 U.S.C. 102(b) as being anticipated by Mater (3,598,393). This rejection remains in effect. Please see Response to Arguments below.

Inventorship

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claims 10 and 30 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Mater (3,598,393). This rejection remains in effect. Please see Response to Arguments below.
8. Claims 8, 9, 28 and 29 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Mater (3,598,393) in view of Zettel (3,310,990) or Halverstadt (3,273,248) or Johnston (1,485,460). This rejection remains in effect. Please see Response to Arguments below.

Response to Arguments

9. Applicant's arguments filed 9/28/2004 have been fully considered but they are not persuasive. It was noted earlier that the Examiner believes the new limitations are unsupported by the Specification. The Examiner also believes that even with this limitation the claims are not distinguishable over the prior art.

In traversing the rejections made by the previous Examiner, applicant has amended the claim to recite an alignment arm that limits movement of the blade element to the longitudinal axis and then argued that this feature is not present in the prior art Mater. The Examiner respectfully disagrees and directs applicant to a passage

from the previous Examiner's arguments (page 8 of the previous Office Action, mailed 7/02/2004:

"Examiner maintains that Mater does teach an alignment arm for moving the blade in a linear motion. Mater not only relies on a rotation motion for drilling but also a linear motion to push the drill bit into the pole to make a hole through the entire length of the pole. The linearity and straightness of the pole require the alignment arm to move the blade in a linear motion to feed the drill bit through the pole. Mater's abstract states: The guide tube is rotated slowly to dislodge chips and facilitate movement of the guide tube into the bore being formed. A carriage slidable on tubular ways and guides slidable on the ways support the guide tube and is moved forwardly slowly by a cable drive to feed the drill and is returned rapidly by the cable drive. The drills are moved forwardly from opposite ends of the pole to be drilled until one drill reaches the end of its feed stroke and then this drill is retracted while the other drill completes its stroke. Column 1, lines 29-32, 36-43, and 55-61 of Mater states: Another object of the invention is to provide a drill in which an inner drill tube drives a drill bit forming a bore large enough to slidably receive an outer guide tube journaling the drill tube. Another object of the invention is to provide a drill supported by guides, which are initially spaced apart and by a carriage which pushes the guides forwardly toward a pole as a bore is formed in the pole. Preferably, the air is introduced into the drill through a rotary coupling sealingly engaging both the guide tube and the drill tube, and the guide tube preferably is rotated slowly to facilitate feed of the guide tube into the bore."

While this passage was originally written by the previous Examiner in response to applicant's argument that Mater does not teach an alignment arm for moving the blade linearly, the current Examiner has provided it since he feels it is relevant to the current claims/arguments. As noted by the previous Examiner in the passage, the drill bit is limited to longitudinal movement because it is surrounded by a bore and a guide tube! Therefore, the current Examiner fails to see how the drill bit of Mater could move in a direction other than within the guide or bore – a direction that is longitudinal with

reference to Mater's system. Since applicant's arguments are drawn solely to the reference Mater and the amended claim(s), the claims remain rejected.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DKH
December 12, 2004


Jill Warden
Supervisory Patent Examiner
Technology Center 1700